

REMARKS

This responds to the Office Action dated December 30, 2005, and the references cited therewith.

Claims 1, 2, 5, 10, 13-16, 19-20, 28, 35-38, 40-44, 47, 50-54, 56, 58-60, 67-70, 121, 127-133, 137-138, 141, 143, 147, 149, 152-153, and 164-168 are amended, claims 32-34, 99-120, 123-126, 136, 140 and 169-183 are canceled herein, claims 63-66 and 71-98 and 134-135 were previously canceled, and claims 184-195 are added; as a result, claims 1-31, 35-62, 67-70, 121-122, 127-133, 137-139, 141-168, and 184-195 are now pending in this application with claims 8-9, 12, 23-29, 46, 49, 154-159, and 162-163 withdrawn from prosecution at this time.

Claims 32-34, 99-120, 123-126, 136, 140 and 169-183 have been canceled solely to advance the prosecution of the present application, and without prejudice to their further prosecution in an appropriately filed continuation or divisional application.

The amendments made herein are to clarify the claims and to correct typographical errors and are not intended to limit the scope of equivalents to which any claim element may be entitled. Claims 2, 149 and 166 were amended to clarify that the composition further comprises an additional rare earth compound (claims 2 and 149) and that the method further comprises adding an additional rare earth compound. The amendments to the claims and new claims have support throughout the specification and in the original claims. No new matter has been added as a result. Applicants respectfully request reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

Affirmation of Election

Restriction to one of the following inventions was required: Group I (claims 1-31, 35-74, 76-83, 87-98, 121, 122, 127-133, and 137-139), drawn to a composition; and Group II (claims 32-34, 84-86, 99-120, 123-126, 136, and 140), drawn to a coated substrate. Applicants elected Group I in the response mailed on August 22, 2005 and added new claims drawn to both Group I and Group II. As the Examiner notes, Applicants further elected the species "mixed oxides" in the response mailed on August 22, 2005 and "linear and cyclic dextrans" in the response mailed on October 13, 2005.

As the restriction is made final, Applicants confirm the election to prosecute the invention of Group I. The Examiner has withdrawn the claims to both the non-elected invention and the non-elected species, i.e., claims 8, 9, 12, 23-29, 32-34, 46, 49, 99-120, 123-126, 136, 140, 154-159, 162, 163 and 169-183. Applicants note that claims 32-34, 99-120, 123-126, 136, 140 and 169-183 fall within the scope of Group II and the Examiner asserts that claims 9, 12, 23-29, 46, 49, 154-159, 162 and 163 are drawn to non-elected species.

However, Applicants respectfully submit that claims 9, 12, 46 and 49 are drawn to elected species. Claims 9 and 12 indirectly depend from claim 2 and claims 46 and 49 indirectly depend from claim 35. Both claims 2 and 35 as amended can include the elected species. Accordingly, Applicants respectfully request that claims 9, 12, 46 and 49 be reinstated and examined.

Applicants have canceled claims that fall within the scope of Group II, i.e., claims 32-34, 99-120, 123-126, 136, 140 and 169-183 without prejudice or disclaimer and reserve the right to later file continuations or divisions having claims directed to the non-elected invention(s).

Claim Objections

Claim 141

Claim 141 is objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 141 has been amended to add the phrase "at least about 1 weight %."

It is believed that the amendment made herein to claim 141 obviates said objections.

Reconsideration and withdrawal of this objection are respectfully requested.

Claims 11 and 56

Applicants were advised that should claim 11 be found allowable, claim 56 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. Applicants respectfully traverse this assertion.

Claim 56 is directed to a corrosion inhibiting primer composition and claim 1, as amended, is directed to a corrosion inhibiting coating composition. Therefore, claims 11 and 56 are not substantial duplicates.

Reconsideration and withdrawal of this objection are respectfully requested.

§112 Rejection of the Claims

Claims 1-22, 30, 31, 67-69, 127-131, 141-146, and 164-168

Claims 1-22, 30, 31, 67-69, 127-131, 141-146, and 164-168 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

With respect to claims 1, 13, 14, 67, 144-146 and 164, the Examiner asserts that the ranges of “at least about 1 wt%,” “at least 3 wt%,” “at least about 28 wt%,” and “at least 40 wt%” are open-ended ranges which fail to satisfy the written description requirement. The Examiner was unable to find any support for these ranges in the specification. Claims 2-12, 15-22, 30, 31, 68, 69, 127-131, 141-143 and 165-168 were also rejected for being dependent on a rejected claim.

Applicants respectfully submit that the specification provides support for the claimed ranges. As shown in Table 1A on page 18, the rare earth compounds, including Pr_6O_{11} can have a range of 0.1 - 90 wt%. This provides a broad range of weight percentages of rare earth compounds that may be claimed. As explained in par. 52 on page 18, Table 1A is described as showing “other preferred ranges” and does not constitute absolute range limits. There is nothing in the specification to indicate that 90 wt% is a critical upper limit. However, one skilled in the art would understand that there is an implied upper limit to the ranges that is less than 100 wt%, because of the presence of the one or more binders.

Therefore, Applicants respectfully submit that the open ended ranges of claims 1, 13, 14, 67, 144-146 and 164 find full support in the specification. See e.g., *Ralston Purina co. v. far-Mar-Co., Inc.*, 772 F.2d 1570 (Fed. Cir. 2000), in which an Example in the specification having a temperature range of 212°F -380°F provided support for a claim limitation of “at least about 212°F”

Additionally, the specification provides support for the lower limits of the claimed ranges. See, for example, par. 52 on page 18 wherein it states, “Preferred for the practice of one embodiment of the present invention is a . . . paint composition comprising about 0.1 to about 40 wt% Pr_6O_{11} . Particularly preferred in this embodiment is about 0.1 to about 28 wt% Pr_6O_{11} .” See

also, for example, par. 83 in Example 3 on page 29 wherein it states, "The concentration of the corrosion inhibitors used as individuals range from about 1 wt% (Pr_6O_{11} , panel A22) to about 22.2 wt% (Pr_6O_{11} panel 227)."

Table 3 in Example 12 has many examples of tests conducted with praseodymium compounds at 1 wt% and 3 wt%. See, for example, on page 40: Panel A1 with 3 wt% of PrCl_3 , Panels A5 and A8 with 1 wt% of $\text{Pr}(\text{NO}_3)_3$, Panels A2 and A3 with 3 wt% of $\text{Pr}(\text{NO}_3)_3$, Panels A19 and A21 with 1 wt% and 3 wt%, respectively, of PrCO_3 . See also, for example, on page 41: Panels A28, C13, C14, C18 and C19 with 1 wt% Pr_6O_{11} . See also, for example, on page 42: Panel A59 with 1 wt% of $\text{Pr}(\text{CF}_3\text{SO}_3)_3$. See also, on page 43, Panel A22 with 1 wt% of Pr_6O_{11} and Panels A10, A41 and A25 at 3 wt% of Pr_6O_{11} . Additional examples are listed throughout Table 3.

The above passages from the specification provide a basis for the lower range endpoints of 1 wt%," "3 wt%," "28 wt%," and "40 wt% as claimed. Moreover, all of the lower range endpoints are found within the preferred ranges disclosed in the specification. Applicants respectfully submit that those skilled in the art would consider all of the claimed ranges inherently supported by the discussion in the original disclosure. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Reconsideration and withdrawal of the rejection of claims 1-22, 30, 31, 67-69, 127-131, 141-146 and 164-168 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claims 133 and 143

Claims 133 and 143 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Examiner states that claim 133 is dependent on a canceled claim, and that in claim 143 the term "praseodymium (III/IV) mixed oxide" lacks antecedent basis.

Applicants have amended claim 133 to depend on claim 62. Additionally, Applicants have amended claim 143 to provide proper antecedent basis for the term "praseodymium (III/IV) mixed oxide".

Applicants respectfully submit that the amendments made herein to the claims obviate said objections.

Reconsideration and withdrawal of these objections are respectfully requested.

§102 Rejection of the Claims

Claims 1-5, 7, 10, 11, 13, 17, 19, 20, 56-59, 67, 68, 139, 141-144, 149, 150, and 164-166

Claims 1-5, 7, 10, 11, 13, 17, 19, 20, 56-59, 67, 68, 139, 141-144, 149, 150, and 164-166 were rejected under 35 U.S.C. § 102(b) for anticipation by Andou (U.S. 6,294,006). This rejection is respectfully traversed.

The Examiner states that Andou discloses an anticorrosive paint to protect steel ships and pipes comprising a binder and 8 to 15 wt% of an anticorrosive and antifouling additive containing rare earth metal oxides such as Pr_6O_{11} . The Examiner calculates the amount of Pr_6O_{11} to be about 3 wt% to 4 wt% based on the coating composition. Applicant respectfully traverses this assertion that Andou teaches about 3 wt% to 4 wt% of Pr_6O_{11} .

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). To constitute anticipation, the claimed subject matter must be identically disclosed in the prior art. *In re Arkley*, 172 U.S.P.Q. 524 at 526 (C.C.P.A. 1972). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the art. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 101 (Fed. Cir. 1991). To overcome the defense of anticipation, "it is only necessary for the patentee to show some tangible difference between the invention and the prior art." *Del Mar Engineering Lab v. Physio-Tronics, Inc.*, 642 F.2d 1167, 1172, (9th Cir. 1981).

Andou discusses an anticorrosive and antifouling additive for paints which is added in an amount of 8 to 15% (Col. 3, lines 23-26) with respect to paint weight. The additive comprises a maximum of 94% by weight of Chinese complex mineral (Col. 3, line 65 through col. 4, line 2). Chinese complex mineral powder contains CeO_2 (52.2%), La_2O_3 (25.9%), Nd_2O_3 (16.3%), Pr_6O_{11} (5.40%), Sm_2O_3 , Eu_2O_3 , Gd_2O_3 , Y_2O_3 and so on (0.2%). (Col. 4, lines 34-37). Therefore,

the maximum amount of Pr_6O_{11} contained in the paints of Andou is $0.15 \times 0.054 \times .94$ or 0.76 wt%, not 3 to 4 wt % as asserted in the Office Action.

In contrast, claims 1, 67, and 164, as amended, recite at least about 1 wt% of a praseodymium oxide selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides, hydroxides and combinations thereof. Also in contrast, claim 56 recites at least about 1 wt% of a praseodymium (III/IV) mixed oxide.

Applicant cannot find, in Andou, a coating that contains at least about 1 wt% of a praseodymium oxide selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides, hydroxides and combinations thereof or at least about 1 wt% of a praseodymium (III/IV) mixed oxide.

Thus, Andou does not teach each element of claims 1, 56, 67 or 164. Therefore, Andou does not anticipate the claims, as amended. Applicants respectfully submit that claims 1, 56, 67 and 164 are allowable in their present form. Since claims 2-5, 7, 10, 11, 13, 17, 19, 20 and 141-144, depend from and further define claim 1; claims 57-59 and 149 depend from and further define claim 56; claims 68, 139 and 150 depend from and further define claim 67, and claims 165 and 166 depend from and further define claim 164, these claims are also believed to be allowable in their present form. Notification to this effect is respectfully requested.

§103 Rejection of the Claims

Claims 1-7, 13-20, 30, 31, 35-38, 40-45, 50-52, 54, 55, 67-70, 121, 122, 127-129, 131, 133, 137-139, 141, 142, 147-152, 160, 164, and 166-168

Claims 1-7, 13-20, 30, 31, 35-38, 40-45, 50-52, 54, 55, 67-70, 121, 122, 127-129, 131, 133, 137-139, 141, 142, 147-152, 160, 164, and 166-168 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. 6,190,780).

The Examiner asserts that Shoji teaches various elements of the claims. (The Examiner admits on page 7 that Shoji fails to disclose the use of mixed oxides, in particular, praseodymium(III/IV) mixed oxide).

Applicants respectfully submit that the Examiner has not established the *prima facie* obviousness of the present claims. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Furthermore, claims 2-7, 13-20, 30, 31, 36-38, 40-45, 50-52, 54, 55, 68-70, 122, 127-129, 131, 133, 137-139, 141, 142, 147-152, 160 and 166-168 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Shoji does not teach or suggest the claimed invention. Shoji discusses films that can contain oxyacid and hydrogen oxyacid rare earth compounds and/or Group IV elements with oxyacid anions. Shoji mentions coatings in a resin matrix which can contain rare earth oxides, hydroxides, chlorides or other salts.

In contrast, claim 1, as amended, recites a corrosion inhibiting coating composition comprising at least about 1 wt% of a praseodymium oxide selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides, hydroxides, and combinations thereof; and a binder. Also in contrast, claim 67, as amended, recites a corrosion inhibiting coating composition comprising a binder; one or more rare earth element oxides selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides and hydroxides; and a praseodymium oxide selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides, hydroxides, and combinations thereof, wherein the praseodymium oxide is present in an amount of at least about 1 wt%. Also in contrast, claim 164, as amended, recites a method for preparing a coating composition comprising preparing a paint formulation; and adding an effective corrosion-inhibiting amount of at least about 1 weight percent of a praseodymium oxide selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides, hydroxides, and combinations thereof to the paint formulation to produce a coating composition.

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. MPEP § 2144.08 (II) citing *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be compassed by a disclosed generic formula does not by itself render that compound obvious.”)

First, there is no suggestion or motivation to make the claimed invention in light of the prior art teachings as required by MPEP § 2144.08 (IIA) citing *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). Although Shoji mentions coatings in a resin matrix which can contain rare earth oxides, hydroxides, chlorides or other salts, there is no teaching or suggestion in the prior art as to the desirability of modifying or replacing the disclosed compounds with the specific species recited in the claims. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 142 (Fed. Cir. 1991).

Second, there is no reasonable expectation of success. It is also not clear that modification of Shoji to contain at least about 1 wt% praseodymium oxide would be successful. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Applicants request the Examiner to either provide evidence of such motivation or withdraw this rejection.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Since all of the elements of the claims are not found in Shoji, Applicants respectfully traverse the single reference rejection and assumes the Examiner is taking Official Notice of the missing elements from an undisclosed source. Applicants respectfully object to the taking of Official Notice for all the reasons stated herein, and pursuant to MPEP 2144.03, requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing element, Applicants respectfully request that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicants request withdrawal of the rejection and reconsideration and allowance of the claims.

Additionally, Applicants cannot find any teaching or suggestion of an extender in Shoji, including a neutral to slightly acidic generating extender or an acidic generating extender as recited in the claims. In contrast, claim 35, as amended, recites a corrosion inhibiting composition comprising a rare earth compound; a binder; and one or more extenders selected from the group consisting of a neutral to slightly acidic generating extender, an acidic generating extender, and combinations thereof. Also in contrast, claim 70, as amended, recites one or more extenders selected from the group consisting of a neutral to slightly acidic generating extender, an acidic generating extender, and combinations thereof. Also in contrast, claim 121, as amended, recites a method for preparing a coating composition comprising preparing a paint formulation; and adding an effective corrosion-inhibiting amount of a rare earth compound and one or more extenders selected from the group consisting of a neutral to slightly acidic generating extender, an acidic generating extender, and combinations thereof to the paint formulation to produce a coating composition.

Clearly there is no suggestion or motivation to make the claimed invention in light of the prior art teachings and there is no reasonable expectation of success. Shoji again fails to teach all of the elements of the claims as required and Applicants traverse the single reference rejection and requests an affidavit for all the reasons stated above.

Thus, the *prima facie* obviousness of claims 1, 35, 67, 70, 121 and 164 has not been established. The Federal Circuit has held that "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir.1992).

Applicants respectfully submit that independent claims 1, 35, 67, 70, 121 and 164 and the claims which depend from them are patentably distinct from the cited references, either alone or in combination. Claims 1-7, 13-20, 30, 31, 35-38, 40-45, 50-52, 54, 55, 67-70, 121, 122, 127-129, 131, 133, 137-139, 141, 142, 147-152, 160, 164, and 166-168, as amended, each viewed as a whole, are not suggested by the cited references and are not obvious under 35 USC 103(a).

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 7, 10, 11, 45, 47, 48, 56-59, 61, 62, 68, 132, 142-146, 150, 161, and 165

Claims 7, 10, 11, 45, 47, 48, 56-59, 61, 62, 68, 132, 142-146, 150, 161, and 165 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. 6,190,780) in view of Andou (U.S. 6,294,006). This rejection is respectfully traversed.

The Examiner asserts that the references teach various elements of the claims. The Examiner again asserts that Andou teaches 8 to 15 wt% of rare earth metal oxides such as Pr_6O_{11} . The Examiner concludes that it would have been obvious to utilize the praseodymium mixed oxide as one of the anticorrosion additives of Shoji since it teaches the use of rare earth metal oxides.

Applicants again respectfully submit that the *prima facie* obviousness of the claims has not been established.

Claims 7, 10, 11, 45, 47, 48, 57-59, 61, 62, 68, 132, 142-146, 150, 161, and 165 are dependent claims dependent on claims 1, 35, 56, 67, 70, 121 and 164. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Shoji does not teach or suggest the present invention for all the reasons stated herein. Andou does not overcome the deficiencies of Shoji for all the reasons stated herein. The maximum amount of Pr_6O_{11} in Andou is 0.76%.

The deficiencies of Andou and Shoji are discussed above with regard to independent claims 1, 35, 67, 70, 121 and 164. Additionally, independent claim 56 recites a corrosion inhibiting primer composition comprising at least about 1 wt% of a praseodymium (III/IV) mixed oxide; and a binder. As explained above, neither Andou nor Shoji alone, or in combination, teach or suggest a composition comprising at least about 1 wt% of a praseodymium (III/IV) mixed oxide; and a binder.

Additionally, there is simply no suggestion in Shoji *as to the desirability* of using a praseodymium (III/IV) mixed oxide as the Examiner suggests. Indeed, Shoji states that it is difficult to form satisfactory films with compounds other than oxyacid compounds and hydrogen oxyacid compounds. (See col. 12, lines 34-36). Moreover, there is no mention of testing with any type of praseodymium compound, with the testing limited to certain cerium compounds in Table 23-30 or lanthanum and neodymium compounds in Tables 31-34. Shoji further discusses

yttrium and zirconium compounds in a resin matrix (see col. 4, lines 42-46 and 49-51). However, Shoji fails to teach or suggest the desirability of using any type of praseodymium compound. Additionally, Shoji fails to teach or suggest the desirability of using one or more rare earth compounds; and one or more extenders consisting of a neutral to slightly acidic generating extender, an acidic generating extender or combinations thereof.

It is also not clear that such a modification would be successful. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Additionally, motivation to combine the references must come from within the references themselves and cannot be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one skilled in the art, to combine the reference teachings as suggested. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir.1988). Applicants request the Examiner to either provide evidence of such motivation or withdraw this rejection.

It has also been established that the Examiner must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The statement in the Examiner that, "it would have been obvious to utilize the praseodymium mixed oxide as one of the anticorrosion additives of Shoji since it teaches the use of rare earth metal oxides," is a conclusory statement of subjective belief. Conclusory statements do not adequately address the issue of motivation to combine. *In re Sang Su Lee*, supra. Essentially, the current invention has been used as a roadmap to identify the purpose leading one to make the combination. The Examiner has not provided objective evidence for a suggestion or motivation to combine the references and the rejection should be withdrawn.

Applicants respectfully submit that independent claims 1, 35, 56, 67, 121 and 164 and the claims which depend from them are patentably distinct from the cited references, either alone or in combination. Claims 7, 10, 11, 45, 47, 48, 57-59, 61, 62, 68, 132, 142-146, 150, 161, and 165, as amended, each viewed as a whole, are not suggested by the cited references and not obvious

under 35 U.S.C. § 103(a). Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 21 and 22

Claims 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. 6,190,780) in view of Oakes (U.S. 4,370,256). This rejection is respectfully traversed.

Claims 21 and 22 depend directly or indirectly on amended independent claim 1 and by definition contain all of the limitations of claim 1. As explained above, Shoji et al., fails to teach or suggest a composition comprising “at least about 1 wt% of a praseodymium oxide” as claimed in claim 1. Applicants respectfully submit that Oakes fails to cure the deficiencies of Shoji et al. discussed above.

Additionally, Applicants respectfully disagree with the portion of Examiner’s characterization of col. 11, lines 4-19 as indicating that Shoji et al. is open to the use of other anticorrosive additives and submit that one skilled in the art would find no motivation to consider unlisted anticorrosive additives upon viewing Shoji et al. One skilled in the art would have no motivation to combine Shoji et al. and Oakes as proposed by the Examiner.

Thus, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections based on Shoji in view of Oakes.

Claims 39, 130, and 153

Claims 39, 130, and 153 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. 6,190,780) in view of Reuter et al. (U.S. 2003/0082368). This rejection is respectfully traversed.

Applicants respectfully submit that claims 39, 130 and 153 are allowable because they depend indirectly on amended independent claims 1 or 35 or 70 which Applicants submit is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending therefrom is allowable. Claims 39, 130 and 153 are further allowable because Reuter does not cure the deficiencies discussed above with respect to Shoji.

Additionally, Applicants respectfully disagree with the portion of Examiner's characterization of col. 11, lines 4-19 as indicating that Shoji et al. is open to the use of other anticorrosive additives and submit that one skilled in the art would find no motivation to consider unlisted anticorrosive additives upon viewing Shoji et al. One skilled in the art would have no motivation to combine Shoji et al. and Reuter et al. as proposed by the Examiner.

Thus, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections based on Shoji in view of Reuter.

Claims 53 and 60

Claims 53 and 60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shoji et al. (U.S. 6,190,780) or in view of Andou (U.S. 6,294,006), and further in view of Tucker (U.S. 3,837,894).

Applicants respectfully submit that claims 53 and 60 are allowable because they depend indirectly on amended independent claims 35 and 56 which Applicants submit is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending therefrom is allowable. Claims 53 and 60 are further allowable because Tucker does not cure the deficiencies discussed above with respect to the combination of Shoji in view of Andou.

Thus, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections based on Shoji in view of Andou and further in view of Tucker.

Double Patenting Rejection

Claims 1-7, 11, 15, 17, 35, 70, and 151 were provisionally rejected under a non-statutory double patenting rejection, specifically claims 39-41 of co-pending U.S. Application No. 10/758,973 (published as US 2004/0186201, cited on IDS filed 3/16/2005). Applicants do not admit that the claims are obvious in view of U.S. Published Application No. 2004/0186201. The Applicants will submit a Terminal Disclaimer to obviate any remaining double patenting rejections upon receiving an indication of allowance in the instant Application.

New Claims

Applicants have added new claims 184 to 195 to more completely claim the present invention. Full support for the new claims is found in the specification and drawings as filed, for example, in paragraphs 16, 21 and 33 of the specification. No new matter has been added. Entry of these new claims is respectfully requested. Additionally, Applicants respectfully submit that new claims 184 to 195 are patentable over the art cited by the Examiner as explained above with regard to claims 1, 7, and 15. Accordingly, Applicants respectfully submit that new claims 184 to 195 are in condition for allowance and indication of allowance is respectfully requested.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 612-373-6920 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JAMES STOFFER ET AL.

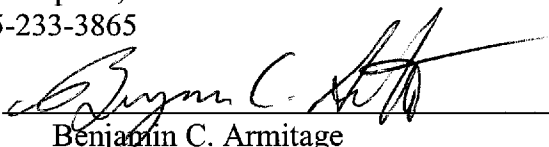
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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of June 2006.

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